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REMARKS

Claims 1 - 16 are currently pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

35 U.S.C. § 103 Rejections

Claims 1 and 9 stand rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent Application No.: 2002/0143871 to Meyer *et al.* in view of U.S. Patent No.6,182,072 to Leak *et al.* Claims 2 - 3 and 10 - 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer *et al.* in view of U.S. Patent No.: 6,671,692 to Marpe *et al.* Claims 4 - 7 and 12 - 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer *et al.* and Marpe *et al.* in view of U.S. Patent Application No.: 2002/0186239 to Komuro. Claims 8 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer *et al.* in view of Komuro.

Applicants submit that the rejections of claims 1 - 16 are rendered moot in view of the submitted Declaration under 37 C.F.R. §1.131, by the named inventors. More specifically, Applicants submit that the Rule 131 Declaration is formally and substantively sufficient to establish that the Inventors had conceived and reduced to practice with due diligence the invention defined in at least independent claims 1, 2, 3, 8, 9, 10, and 11 starting before the effective date of the primary reference to Meyers, *et. al.*, i.e., **January 23, 2001**. The statements in the Declaration show that the formal requirements of §1.131 are satisfied, namely:

- (1) the rejections to be overcome are under §102(e) and/or §103(a),
- (2) all the acts for completing the invention of claims 1, 2, 3, 8, 9, 10, and 11 were performed in this country, and
- (3) the effective date of the Meyer reference, i.e., January 23, 2001, is not more than one year prior to the filing date of the present application in this country.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. §1.131. The Declaration sets forth specific

facts, of sufficient character and weight, to establish a **date of conception** before the effective date of the Meyer reference of January 23, 2001, and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective filing date of the Meyer primary reference to a constructive reduction to practice, i.e., to the filing of the application.

Date of Conception

As stated in the Declaration, an on-chip logic analysis system including a single chip device including a signal processing unit and a host unit externally provided as disclosed and recited in claims 1, 2, 3, 8, 9, 10, and 11 of the application (and those claims dependent thereon) was conceived by the Inventors before the effective date of the Meyer reference. Invention disclosure documentation is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that at least the invention disclosure evidence shows that the Inventors had a definite and permanent idea of the complete and operative invention of claims 1, 2, 3, 8, 9, 10, and 11, as presently pending, prior to the January 23, 2001 effective date of the Meyers reference.

In particular, the accompanying evidence shows, at least textually, the features of claims 1, 2, 3, 8, 9, 10, and 11. The original copy of the invention disclosure documentation evidences a date antedating the January 23, 2001 effective date of the Meyers reference. This and all other pertinent dates have been removed from the photocopies submitted with the Declaration to prevent any potential prejudice to Applicants. It is noted that any figures provided are illustrative in nature and are not intended as limiting features of the invention.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of claims 1, 2, 3, 8, 9, 10, and 11 starting before January 23, 2001 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§ 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicants' date of conception of the invention in this country before the effective date of the Meyer reference.

Due Diligence

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the January 23, 2001 effective date of the Meyer reference to a constructive reduction to practice, realized by the filing of the above-identified patent application on November 16, 2001.

The invention disclosure documentation was completed by the Inventors and submitted to IBM in-house patent counsel prior to the Meyer reference date of January 23, 2001. Numerous discussions between the Inventors and counsel took place until a first draft of the application was forwarded to Inventors, Waheed Sujjad and Cary L. Bates. At least one such communication occurred on November 11, 2000. Another communication occurred on February 27, 2001. Revisions were made and subsequent drafts were prepared and reviewed by the Inventors, until a final draft was forwarded to IBM for filing on April 5, 2001.

IBM in-house patent counsel also acted in an expeditious manner to prepare and forward the application to filing. Under M.P.E.P. § 2138.06, only ***reasonable*** diligence is required in this regard. More specifically, § 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order.

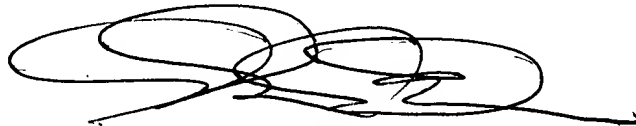
Applicants respectfully submit that the Declaration shows that their patent attorneys acted sufficiently expeditiously to satisfy the requirements of due diligence. Applicants submit that the Declaration submitted herewith are sufficient to show that the Inventors and their attorneys exercised due diligence the due diligence required under 37 C.F.R. § 1.131. The Declaration shows that at least one Inventor remained in regular contact with patent attorneys to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for enabling the application to be filed in an expeditious manner.

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CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Applicants submit that all of the claims are allowable and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Prompt and favorable consideration of this reply is respectfully requested. Please charge any deficiencies in fees and credit any overpayment of fees to **IBM Deposit Account No. 09-0457 (Endicott)**.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a stylized flourish at the end.

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